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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,904	05/31/2000	Avner Shafrir	52817.000111	2748

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EXAMINER

HAILU, TADESSE

ART UNIT	PAPER NUMBER
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2173

21

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,904

Applicant(s)

SHAFRIR ET AL.

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the patent application (09/427,680) filed on 10/27/1999.
2. The patent application claims priority from domestic US Application 60/137,513 filed June 2, 1999.
3. The pending claims 1-31 are examined herein as follows.

Claim Rejections - 35 U.S. C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-31 are rejected under 35 U.S.C 103(a) as being unpatentable over Mirabilis LTD. Quick Tour. February 12, 1998 in view of ICO Inc. ICO Email Signature, May 2 1999.

ICQ, as described and illustrated in Mirabilis LTD, Quick Tour, is an application that is used as a tool for communication. After installing this software application in a computer, ICQ allows you to know who is online (network), and allows you to contact them by clicking the name or the icon next to it and then send a message, initiate a chat session or launch any other interactive session (communication mode). ICQ automatically detects user connection to the Internet and announces your presence

(on-line status indicator) to those whose list (contact list) you are on and notifies you if your contacts are on-line (status indicator) as well. This status indicator is color-coded symbol (flower icon), i.e., it changes to green to announce your presence to those whose list you are on.

Moreover, as described below, it is clear that the current claims are not distinguishable over the cited art.

Per claim 1:

As per "status determining means," ICQ, as describes and illustrates in Quick Tour, does provide plurality of status determining indicators to know the status (online, offline, etc.) of one or more users on the Internet (Quick Tour, page 5).

As per "status indicator presenting means," as mentioned above, ICQ, as describes and illustrates in Quick Tour, provides the status indicator (such as online or offline) and also provides user indicators (such as names or IDs) associated with the status indicators. By clicking or selecting the indicator one can establish communication with other users with a selected communication mode (Quick Tour, pages 5-6).

As per "user indicator presentation means," ICQ, as described and illustrated in Quick Tour, does teach a user indicator presentation means, such as name, ICQ's unique ID number, etc that are associated with the user (Quick Tour, pages 1-3). As mentioned above any one of these indicators allows you to connect or link to others by clicking on the indicator (Quick Tour, pages 1-3).

Although ICQ describes user indicator presentation means, but ICQ does not expressly describe "enabling presentation of one ore more user indicators within the two

or more types of electronic documents, wherein the electronic document types are capable of being generated using two or more types of applications and wherein each user indicator is associated with at least one network user.”

ICQ Inc, ICQ Email Signature describes these shortcomings. ICQ, in ICQ Email Signature, explicitly describes enabling any other application to generate and present the status indicator within at least one electronic document (ICQ Email Signature, page 2). ICQ enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the selected applications (ICQ Email Signature, page 2).

Furthermore, Quick Tour in view of ICO Email Signature further discloses that the status can be associated with e-mail, chat or data conference applications that determines a status of a user associated with user indicator (see Quick Tour, pages 5-6

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the user indicator (signature) feature to the previous version of ICQ (How to Use ICQ because it enhances the ICQ communication tool and at the same time this enhancement will benefit the users of both ICQ and non ICQ users as well.

Per claims 6, 13, 18, and 26-29:

The remaining independent claims, 6, 13, 18, 26-29 are rejected for the same reason given to claim 1.

Per claims 2, 4, 14, 16, and 19:

ICQ provides a status indicator such as a flower symbol which changes color (color-coded) based on the user's status (Quick Tour, page 4).

Per claims 3, 8, 15, and 20:

ICQ further discloses status indicators displayed in a menu (Quick Tour, page 5).

Per claims 5, and 17:

As illustrated in page 5, the user indicator is selected by selecting the status indicator icon for the selected user (Quick Tour, pages 4-5).

Per claim 7:

As illustrated in page 5, symbol icon is used to indicate the status indicator of a user (Quick Tour, pages 4-5).

Per claims 9, and 21:

The status indicators includes color-coding, that is, the symbol (flower icon) changes to green to announce your presence to those whose list you are on. (See Quick Tour, pages 4-5).

Per claims 10, 12, 22-25:

ICQ, as mentioned above, does provide several communication preference to a user, such preference include, e-mail, chat, send message files and URLs, play games, draw on whiteboards, communicate through voice while surfing the net (see page 6). User can initiate or establish any one of the communication modes to communicate and share at least one application with one or more users (Quick Tour, page 6).

Per claim 11:

ICQ user is able to establish or initiate one or more communications such as using ICQ's voice, or data sharing applications with one or more network users (Quick Tour, page 6).

Per claims 30 and 31:

ICQ enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the selected applications (ICQ Email Signature, page 2).

Response to Arguments

6. Applicant's arguments filed 3/22/2004 have been fully considered but they are not persuasive.

Applicant argues that "There is no teaching or suggestion in Quick Tour for enabling an application other than the ICQ application to generate the drop down status window," In contrast to the applicant's argument, Quick Tour in view of ICO Email Signature describes enabling any other application to generate and present the status indicator within at least one electronic document (ICQ Email Signature, page 2). ICQ enables users to select any other applications, such as Netscape 3, Microsoft Outlook Express, Eudora, etc. and generate and insert signature, i.e., a user indicator into any one of the selected applications (ICQ Email Signature, page 2).

Applicant also argues that Quick Tour fails to teach or suggest presenting at least the status indicator and the one or more user indicators, wherein the status indicator indicates the status of network users via the two or more types of applications." In

contrast to applicant's argument, Quick Tour in view of ICO Email Signature describes presenting at least the status indicator (see the reason given to the rejection of claim 1). Furthermore, Quick Tour in view of ICO Email Signature describes the status indicator indicates the status of network users via the two or more types of applications. Quick Tour in view of ICO Email Signature further describes that the status can be associated with e-mail, chat or data conference applications that determines a status of a user associated with user indicator (see Quick Tour, pages 5-6)(see reason given to the rejection of claim 1).

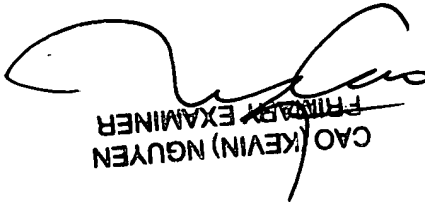
Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 10:00 - 6:30 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51.
9. The Official fax number is (703) 872-9306.
10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu
July 8, 2004


CAO (KEVIN) NGUYEN
PRIMARY EXAMINER